

REMARKS

The following remarks are submitted to address the above amendments and issues raised in the Official Action mailed October 4, 2006.

A Request for Extension of Time to extend the period for responding to this Office Action to April 4, 2007, is filed herewith.

Upon entry of the foregoing amendments, claims 1- 42 are now pending in this application. Claims 13-18 stand withdrawn from consideration as being drawn to a non-elected invention. Claim 1-12 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims of U.S. Patent Nos. 6,997,190; 6,976,493; and 6,929,013. Claims 1-12 stand rejected under 35 USC § 103(a) as being unpatentable over U.S. Patent No. 4,739,775, to Hampl, Jr. New claims 19-42 have been added herein.

No new matter has been added. Support for requested amendments can be found in the original claims and throughout the present specification and drawings. Applicant respectfully requests consideration of the application in light of the above amendments and the following remarks.

Claims 1-12 — Double Patenting

The rejections of claims 1-12 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims of U.S. Patent Nos. 6,997,190; 6,976,493; and 6,929,013 are respectfully traversed.

The Official Action states that claims 1-12 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims of U.S. Patent Nos. 6,997,190; 6,976,493; and 6,929,013; and that although the conflicting claims are not identical, they are not patentably distinct from each other because of the fact that the instant claims claim the method in which the coating layers are applied, i.e., by spraying or ink jet, which is not

deemed to be a patentable distinction because the above claims are product-by-process claims, the determination of patentability of which is based on the product itself and not on its method of production. (Official Action, para. 2.)

Applicant submits herewith a “terminal disclaimer” to obviate the double patent rejections over prior U.S. Patent Nos. 6,997,190; 6,976,493; and 6,929,013, each of which is commonly owned by the owner of the present application. Therefore, the rejections of claims 1-12 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims of U.S. Patent Nos. 6,997,190; 6,976,493; and 6,929,013 have been obviated.

For all of these reasons, the Office is respectfully requested to withdraw the rejections of claims 1-12 on the ground of nonstatutory obviousness-type double patenting.

Claims 1-12 — 35 USC § 103(a)

The rejections of claims 1-12 under 35 USC § 103(a) as being unpatentable over Hampl, Jr. are respectfully traversed.

Claim 1 of the present invention claims “[a] wrapping material suitable for making a smoking article, the wrapping material comprising: a smoking article wrapping material substrate having a plurality of bands of *layers of a coating formulation* deposited in a pattern on the substrate, at least one of the coating layers applied by spraying.” (Claim 1, emphasis added.)

Claim 6 of the present invention claims “[a] wrapping material suitable for making a smoking article, the wrapping material comprising: a smoking article wrapping material substrate having a plurality of bands of *layers of a coating formulation* deposited in a pattern on the substrate, at least one of the coating layers applied by ink jet coating.” (Claim 6, emphasis added.)

Claim 11 of the present invention claims “[a] smoking article having reduced ignition propensity, the smoking article comprising a smokable material disposed in a wrapping material,

the wrapping material comprising: a smoking article wrapping material substrate having a plurality of bands of *layers of a coating formulation* deposited in a pattern on the substrate, at least one of the coating layers applied by spraying, wherein each of the plurality of bands comprises (a) a first coating layer effective in reducing the inherent porosity of the substrate, and (b) a second coating layer overlying the first coating layer.” (Claim 11, emphasis added.)

Claim 12 of the present invention claims “[a] smoking article having reduced ignition propensity, the smoking article comprising a smokable material disposed in a wrapping material, the wrapping material comprising: a smoking article wrapping material substrate having a plurality of bands of *layers of a coating formulation* deposited in a pattern on the substrate, at least one of the coating layers applied by ink jet coating, wherein each of the plurality of bands comprises (a) a first coating layer effective in reducing the inherent porosity of the substrate, and (b) a second coating layer overlying the first coating layer.” (Claim 12, emphasis added.)

The Official Action states that Hampl, Jr. discloses a wrapper for self-extinguishing and reduced [ignition] proclivity cigarettes wherein the wrapper contains band areas; the wrapper 10 includes a base sheet 12 and band strips 14 (corresponding to the claimed “first coating layer”) attached via glue (corresponding to the claimed “second coating layer overlying the first coating layer”) at spaced intervals 16; and that while Hampl, Jr. may not specifically disclose that at least one of the coating layers is applied by either spraying or ink jet, the above claims are product-by-process claims, and, accordingly, even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself, i.e., differences in product characteristics, and not on its method of production. The Official Action states that in the event that any differences can be shown for the product of the product-by-process claims, as opposed to the product as taught by the reference, such differences would have been obvious to one of ordinary skill in the art as a routine modification of the product in the absence of a showing of unexpected results; and that when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternately on either section 102 or 103 is appropriate. (Official Action, para. 4.)

Hampl, Jr. discloses wrapper constructions for self-extinguishing and reduced ignition proclivity smoking articles. The wrapper constructions comprise a base web of normally burning cellulose fiber paper and one or more bands of a cellulose fiber base web that normally will not sustain burn on a smoking article. The cellulosic fiber band material may contain a reduced level of fillers, and is defined by a “Burn Mode Index.” Selection of band width and inherent porosity can cause a resulting smoking article to be self-extinguishing. The bands may be applied, for example, by gluing or hydrogen bonding, in a plurality of selected zones, with the width and spacing selected to achieve a desired degree of ignition proclivity and free burn time. (Hampl, Jr., col. 2, lines 14-53; col. 4, lines 58-64; and claims 1 and 8.)

Nowhere does Hampl, Jr. disclose “a smoking article wrapping material substrate having a plurality of bands of *layers of a coating formulation* deposited in a pattern on the substrate”, as in claims 1, 6, 11, and 12 of the present invention. Hampl, Jr. also fails to disclose “a second coating layer overlying the first coating layer,” as claimed in claims 11 and 12. In contrast, Hampl, Jr. discloses bands of cellulosic fiber material applied to a base web by gluing or hydrogen bonding. Accordingly, Hampl, Jr. fails to disclose each and every element of the present invention as claimed in claims 1, 6, 11, and 12. Therefore, Applicant respectfully submits that Hampl, Jr. thus fails as a reference for claims 1, 6, 11, and 12.

Applicant respectfully submits that not only does Hampl, Jr. not teach or suggest each and every element of the present invention, Hampl, Jr. provides no suggestion or motivation to modify the product as taught by Hampl, Jr. to provide the products of the present invention. Hampl, Jr. provides no suggestion or motivation to modify the bands of cellulosic fiber material applied to a base web, as disclosed by Hampl, Jr., to provide “bands of *layers of a coating formulation*,” as in claims 1, 6, 11, and 12 of the present invention. Moreover, Hampl, Jr. teaches away from the present invention in that Hampl, Jr. teaches that other “banded” cigarettes with zones treated with chemicals (such as “coating formulations” of the present invention) intended to make the cigarette nonburning consistently failed to achieve a desired balance of free burn and reduced ignition proclivity as in the Hampl, Jr. wrapper constructions. (Hampl, Jr., col. 5, lines 4-20.) Therefore, the results of a “coating formulation” in a smoking article wrapping material substrate useful in manufacture of reduced ignition propensity cigarettes of the present

invention are unexpected. As such, Hampl, Jr. provides no expectation that any modification of the product as taught by Hampl, Jr. would provide the unexpected products of the present invention. As a result, claims 1, 6, 11, and 12 of the present invention are not obvious over Hampl, Jr.

Claims 2-5 depend from claim 1, and claims 7-10 depend from claim 6. Therefore, Applicant respectfully submits that claims 2-5 and 7-10 are likewise not obvious over Hampl, Jr.

For all of these reasons, the Office is respectfully requested to withdraw the rejections of claims 1-12 under 35 USC § 103(a).

New Claims 19-42

Applicant respectfully submits new claims 19-42 herein to further clarify the subject matter of the invention.

CONCLUSION

Applicant submits that a full and complete response has been made herein to the Official Action and, as such, all pending claims in this application are now in condition for allowance. Therefore, Applicant respectfully requests early consideration of the present application, entry of all amendments herein requested, withdrawal of all rejections and objections, and allowance of all pending claims.

The Office is respectfully invited to contact J. Michael Boggs at (336) 747-7536, to discuss any matter relating to this application.

Respectfully submitted,

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Date

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